

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of

UNDERSTEIN

Atty. Ref.: 2802-34 (AMK)

Serial No. 10/510,123

TC/A.U.: 3694

Filed: October 4, 2004

Examiner: M. Cheung

For: MULTI-DEPOSITORY FINANCIAL TRANSACTIONS

* * * * *

August 24, 2009

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellant hereby **appeals** to the Board of Patent Appeals and Interferences from
the last decision of the Examiner.

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(I) REAL PARTY IN INTEREST

The real party in interest is eDEPOSIT Corporation.

(II) RELATED APPEALS AND INTERFERENCES

The Appellant, the undersigned, and the assignee are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal.

(III) STATUS OF CLAIMS

Claims 1-9 and 11-17 are present in this application and are on appeal. Claim 10 has been canceled. No claims have been substantively allowed.

(IV) STATUS OF AMENDMENTS

No amendments have been filed since the date of the Final Rejection.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

The system and method of the described embodiments facilitates transactions between a transferor and a transferee for processing via a depository administrator. The depository administrator generally maintains and administers a single master account 12 at a financial institution such as a bank. The master account 12 is subdivided into a plurality of deposit sub-accounts 14 for its respective customers. The administrator maintains the multiple sub-accounts 14 within the single bank account 12 for its customers, maintaining separate balances, earning separate interest, incurring separate account fees, etc. From the customer's perspective, each customer has an independent account with its balance etc. accessible via the system of the invention. See page 8, lines 6-14.

The system administered by the depository administrator is generally accessible via a global network, such as the Internet. With reference to Fig. 3, a new user can open a deposit sub-account 14 by accessing the depository administrator through the Internet. Once the deposit sub-account is established, the user can enter transactions with other parties using funds in their deposit sub-account or simply effect a transfer or reservation of funds in the deposit sub-account to or for the benefit of another party. See page 8, lines 15-23.

Fig. 4 is an exemplary account activity screen shot showing an available balance for transactions. The system enables the user to send or reserve available funds via links at 16, 18, respectively. When sending or reserving funds, the user, deemed transferor, requests a transfer or hold of funds in the transferor's deposit sub-account to or for the

benefit of a transferee. If the transferor selects the link at 16 to send funds to a transferee, the screen may display the exemplary screen shot illustrated in Fig. 5. The transferor can complete the information requested by the system, including an e-mail address of the recipient/transferee. The system searches its database of e-mail addresses to determine whether the transferee already has a deposit sub-account administered by the depository administrator. If the transferee does not have a deposit sub-account, an e-mail such as that shown in Fig. 6A is sent to the transferee, including a link enabling the transferee to establish a deposit sub-account. In this manner, if the transferee selects the link, the transferee is directed to the sign up/registration section of the system, such as the exemplary screen shot of Fig. 3. If, on the other hand, the transferee has already established a deposit sub-account administered by the depository administrator, an e-mail such as that shown in Fig. 6B is sent to the transferee with a link to accept the payment/fund transfer. See page 8, line 24 – page 9, line 6.

In this context, when the transferor initiates any activity in their deposit sub-account 14, for example by designating funds to pay for goods or services purchased or simply to transfer funds to the transferee, the funds are transferred internally by the depository administrator from one sub-account 14 to another, still within the single master account 12. In such a transaction, the transferor would see a debit entry corresponding to the funds transferred, and the transferee would see a corresponding credit entry. The balance of the single master account 12 would be unchanged, since the transfer occurred internally. See page 9, lines 7-13.

As noted, the transferor may alternatively reserve or hold funds for a pending transaction for the benefit of a particular transferee. In this context, if the transferor selects the link at 18 in Fig. 4, the transferor may be directed to a reserve/hold funds section of the system such as the exemplary screen shot shown in Fig. 8. In this manner, the transferor enters the transferee's e-mail address (or other identification), the amount of funds being reserved and some condition upon the occurrence of which the funds can be transferred. By holding funds in the transferor's deposit sub-account in this manner, the funds are made unavailable to the transferor, giving the transferee assurance that the funds will be transferred upon the occurrence of the predefined condition. See page 9, lines 16-28.

The depository administered via the depository administrator, can be a bank, retail establishment or establishments or the like. See page 10, lines 4-7.

The depository administrator may issue ATM cards to holders of deposit sub-accounts 14 for access to the customer's respective sub-account 14. The cards may encompass debit or check cards or the like and typically contain conventional bank information as well as information for the depository administrator to identify the customer sub-account 14. With these ATM cards and the system of the present invention, a transferor can easily transfer funds to a transferee. For example, the transferor can deposit funds into his deposit sub-account via an ATM or any other conventional means, which funds are then designated for the transferee through the system of the present invention, and the transferee can then receive those funds via withdrawal at any ATM. That is, after depositing the funds, the transferor can access the

system of the present invention via the Internet to effect a transfer of funds to the transferee. The system will then debit the transferor's account and credit the transferee's account in the amount authorized by the transferor. As noted, this transaction will not affect a balance of the depository administrator's master account 12 since the transfer occurs internally. The transferee can then withdraw the funds from any ATM in a conventional manner. See page 10, lines 8-25.

SPECIFIC SUPPORT FOR INDEPENDENT CLAIMS

1. A method of processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository administrator maintaining a master account at a financial institution, the method comprising:

(a) the transferor accessing the depository administrator via a global network using a computer; [page 8, lines 15-16]

(b) the transferor requesting a transfer or hold of funds in the transferor deposit sub-account using the computer via the global network to or for the benefit of the transferee; [page 8, lines 24-29]

(c) if the transferee does not have a transferee deposit sub-account administered via the depository administrator, providing the transferee an opportunity to establish the transferee deposit sub-account; and [page 8, line 31 – page 9, line 6]

(d) the depository administrator processing the funds between the transferor deposit sub-account and the transferee deposit sub-account, wherein each of the sub-

accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account. [page 9, lines 7-13]

16. A computer system for processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository administrator maintaining a master account at a financial institution, the computer system comprising:

at least one user computer running a computer program that enables the transferor to access the depository administrator to request a transfer or hold of funds in the transferor deposit sub-account to or for the benefit of the transferee; and [page 5, line 12 – page 8, line 5; and page 8, lines 15-29]

a system server running a server program, the at least one user computer and the system server being interconnected by a computer network, the system server processing the funds between the transferor deposit sub-account and the transferee deposit sub-account [page 5, line 12 – page 8, line 5], wherein if the transferee does not have a transferee deposit sub-account administered via the depository administrator, the system server providing the transferee an opportunity to establish the transferee deposit sub-account [page 8, line 31 – page 9, line 6], wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account. [page 9, lines 7-13]

17. A computer program embodied on a computer-readable medium for processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository

administrator maintaining a master account at a financial institution, the computer program comprising:

means for the transferor to access the depository administrator via a global network; [page 5, line 12 – page 8, line 5; and page 8, lines 15-16]

means for the transferor to request a transfer or hold of funds in the transferor deposit sub-account to or for the benefit of the transferee; [page 5, line 12 – page 8, line 5; and page 8, lines 24-29]

if the transferee does not have a transferee deposit sub-account administered via the depository administrator, means for providing the transferee an opportunity to establish the transferee deposit sub-account; and [page 5, line 12 – page 8, line 5; and page 8, line 31 – page 9, line 6]

means for the depository administrator to process the funds between the transferor deposit sub-account and the transferee deposit sub-account, wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account. [page 5, line 12 – page 8, line 5; and page 9, lines 7-13]

(VI) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-9 and 11-17 are unpatentable under 35 U.S.C. §103(a) over U.S. Published Patent Application No. 2002/0026396 to Dent in view of U.S. Published Patent Application No. 2001/0034676 to Vasic.

(VII) ARGUMENT

1. Claims 1-9 and 11-17 are not unpatentable under 35 U.S.C. §103(a) over Dent in view of Vasic.

Claim 1 defines a method of processing funds between a transferor and a transferee. At least the transferor has a transferor deposit sub-account administered by a depository administrator. The depository administrator maintains a master account at a financial institution. The transferor accesses the depository administrator and requests a transfer or hold of funds in the deposit sub-account to or for the benefit of the transferee. The depository administrator processes the funds between the transferor deposit sub-account and a transferee deposit sub-account, wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account. As such, the depository administrator is capable of administering an entirely independent system under a single master account at a financial institution while benefiting from the convenience and protection offered by the financial institution.

The Office Action recognizes that Dent lacks at least the claimed sub-accounts that form part of the master account. In this context, however, the Office Action contends that Vasic discloses such subject matter and that it would have been obvious to incorporate such sub-accounts into the system disclosed in Dent in view of the Vasic publication. Appellant respectfully submits, however, that this conclusion is misplaced.

The Vasic publication describes a method for allowing employees to receive payroll and to access payroll on demand, possibly in advance. In particular, the system

enables a third party to receive a request from an employee for payroll access, forwards the requested funds to the employee on demand, and deducts the forwarded funds from the employee's payroll check. In paragraphs [0026] and [0056], Vasic references a master account as a principal payroll access resource and describes a secondary payroll access resource as a sub-account of the master account. In this context, Vasic contemplates that the payroll access company can keep a large master account with funds sufficient to cover payroll access for numerous employees and have separate "sub accounts" for individual employees that remain empty and inactive until an employee requests access. In this context, however, Vasic only describes transfers of funds from the master account into a sub-account from which an employee draws forwarded wages. Vasic does not in any manner contemplate or suggest that employees can transfer funds to each other between the sub-accounts. Vasic additionally describes that the sub-account "actually has no funds until the sub-account is activated by using the [ATM] card and the funds are automatically transferred from the master account or alternatively transferred or wired with associated fees." See paragraph [0056]. That is, funds are never transferred between sub-accounts, but rather are only transferred from the employer's master account administered by the payroll service to the sub-account accessible by the employee. Reference to "transferring funds" in paragraph [0063] similarly merely refers to transferring funds from the employer's master account to a sub-account accessible by an employee.

Appellant thus respectfully submits that the Vasic publication similarly lacks the sub-account features of the invention, particularly relating to transferring funds between

sub-accounts. As a consequence, Appellant submits that Dent in view of Vasic falls short of the claimed invention and that the rejection of independent claim 1 is misplaced.

In the “Response to Arguments” section in the final Office Action, the Examiner contends that “the claim language does not positively recite transferring step, but instead recites a limitation characterizing the sub-account.” To the contrary, however, step (d) in claim 1 specifically recites that the depository administrator processes the funds between the transferor deposit sub-account and the transferee deposit sub-account. Since the Vasic publication does not disclose any capability of processing funds between different sub-accounts, Appellant submits that the conclusions in the Office Action are misplaced and the rejection should be withdrawn. The mere capability of transferring funds between sub-accounts in the Vasic patent is not sufficient to support the conclusion of obviousness. See, e.g., *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)(“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). See also, *Ex parte Levengood*, 28 USPQ2d 1300, 1301–02 (B.P.A.I. 1993) (“That which is within the capabilities of one skilled in the art is not synonymous with obviousness. . . .”).

In paragraph 8, the Office Action notes that “Dent teaches the transfer of funds between accounts.” In contrast with the claimed invention, however, the financial service center 102 in Dent requires that the transaction participants provide access to independent accounts. See, for example, paragraph [0014], [0046], [0050], [0094], [0123] and others. Since the Vasic publication does not even remotely suggest an ability or desire to transfer

funds between sub-accounts, Appellant submits that those of ordinary skill in the art would not look to Vasic to improve the system disclosed in Dent. Even under the Supreme Court's *KSR* decision, the combination of Dent and Vasic would not yield predictable results since the combined teachings would not perform the same functions as they did separately. That is, since the Vasic system neither discloses nor suggests an ability to transfer funds between sub-accounts, incorporating Vasic into the Dent system would require the Vasic system to perform in a way that it does not perform separately. As such, Appellant submits that the rejection is misplaced.

With regard to dependent claims 2-9 and 11-15, Appellant submits that these claims are allowable at least by virtue of their dependency on an allowable independent claim. Moreover, claim 6 recites that step (d) is practiced by holding the funds in the transferor deposit sub-account until receiving confirmation that an event has occurred. In contrast with the claimed "hold" feature, Dent merely describes an authorization button to authorize a particular transaction. Indeed, Dent is silent with regard to any such holding feature. As would be apparent to those of ordinary skill in the art, "held" funds are significantly distinguishable from funds not yet transferred. In the final Office Action, the Examiner contends that "Appellant has provided the Examiner with neither reasoning nor evidence in support of the argument that the authorization feature taught by Dent in par 123 does not fairly suggest the holding features recited in claim 6." In this context, the definition found by the Examiner of the term "hold" is inconsistent with the use of the term in the present specification. As described in the specification, funds that are held in a transferor's deposit sub-account are made unavailable to the transferor,

giving the transferee assurance that the funds will be transferred upon the occurrence of a predefined condition. See, for example, page 9, lines 16-28. In the Dent publication, prior to selecting the authorization button, the funds remain available to the account holder. As such, by Appellant's specific definition of held funds, the funds in the Dent publication do not suggest the feature of claim 6. As noted, this distinction would be readily apparent to those of ordinary skill in the art. Claims 7-9 further define this feature. These additional definitions are similarly distinguishable from merely selecting an authorization button.

Independent claim 16 defines a computer system for processing funds between a transferor and a transferee. A system server processes funds between a transferor deposit sub-account and a transferee deposit sub-account, each of which forms part of a master account such that the transfer of funds between the sub-accounts does not affect a balance in the master account. As discussed above, Vasic lacks any disclosure or suggestion of transferring funds between sub-accounts, but rather merely discloses only a transfer of funds from an employer's master account to an employee's sub-account. As a consequence, Vasic falls short of the claimed invention. For reasons similar to those discussed above with regard to claim 1, Appellant submits that the rejection of claim 16 is also misplaced.

Claim 17 defines a computer program embodied on a computer-readable medium for processing funds between a transferor and a transferee. Claim 17 defines "means for" carrying out the method of claim 1, and Appellant submits that claim 17 is allowable for reasons similar to those discussed above with regard to claim 1.

Reversal of the rejection is requested.

CONCLUSION

In conclusion it is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

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(VIII) CLAIMS APPENDIX

1. A method of processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository administrator maintaining a master account at a financial institution, the method comprising:

(a) the transferor accessing the depository administrator via a global network using a computer;

(b) the transferor requesting a transfer or hold of funds in the transferor deposit sub-account using the computer via the global network to or for the benefit of the transferee;

(c) if the transferee does not have a transferee deposit sub-account administered via the depository administrator, providing the transferee an opportunity to establish the transferee deposit sub-account; and

(d) the depository administrator processing the funds between the transferor deposit sub-account and the transferee deposit sub-account, wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account.

2. A method according to claim 1, wherein step (b) further comprises enabling the transferor to input an E-mail address of the transferee, and wherein the method further comprises alerting the transferee via E-mail that the transfer or hold of funds has been requested.

3. A method according to claim 2, wherein step (c) is practiced by the depository administrator comparing the transferee E-mail address with stored E-mail addresses of deposit sub-account holders to thereby determine whether the transferee has an existing transferee deposit sub-account.

4. A method according to claim 3, wherein if the transferee does not have a transferee deposit sub-account administered via the depository administrator, the step of alerting the transferee via E-mail further comprises providing a link to the depository administrator enabling the transferee to establish the transferee deposit sub-account.

5. A method according to claim 3, wherein if the transferee has a transferee deposit sub-account administered via the depository administrator, the step of alerting the transferee via E-mail further comprises providing a link to the transferee deposit sub-account.

6. A method according to claim 1, wherein step (d) is practiced by holding the funds in the transferor deposit sub-account until receiving confirmation that an event has occurred.

7. A method according to claim 6, wherein the confirmation that an event has occurred comprises confirmation by the transferor.

8. A method according to claim 6, wherein the confirmation that an event has occurred comprises confirmation of product delivery.

9. A method according to claim 6, wherein the confirmation that an event has occurred comprises confirmation of service completion.

10. (Canceled)

11. A method according to claim 1, further comprising issuing automated teller machine (ATM) cards to holders of deposit sub-accounts, and enabling the transferor and transferee to deposit funds or withdraw available funds via their respective ATM cards.

12. A method according to claim 11, further comprising, prior to step (a), the transferor depositing funds into the transferor deposit sub-account using the transferor's ATM card, and after step (d), the transferee withdrawing funds from the transferee deposit sub-account via the transferee's ATM card.

13. A method according to claim 11, further comprising, after step (d), the transferee withdrawing funds from the transferee deposit sub-account via the transferee's ATM card.

14. A method according to claim 1, wherein the depository is a bank.

15. A method according to claim 1, wherein the depository is a retail establishment.

16. A computer system for processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository administrator maintaining a master account at a financial institution, the computer system comprising:

at least one user computer running a computer program that enables the transferor to access the depository administrator to request a transfer or hold of funds in the transferor deposit sub-account to or for the benefit of the transferee; and

a system server running a server program, the at least one user computer and the system server being interconnected by a computer network, the system server processing the funds between the transferor deposit sub-account and the transferee deposit sub-account, wherein if the transferee does not have a transferee deposit sub-account administered via the depository administrator, the system server providing the transferee an opportunity to establish the transferee deposit sub-account, wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account.

17. A computer program embodied on a computer-readable medium for processing funds between a transferor and a transferee, at least the transferor having a transferor deposit sub-account administered via a depository administrator, the depository administrator maintaining a master account at a financial institution, the computer program comprising:

means for the transferor to access the depository administrator via a global network;

means for the transferor to request a transfer or hold of funds in the transferor deposit sub-account to or for the benefit of the transferee;

if the transferee does not have a transferee deposit sub-account administered via the depository administrator, means for providing the transferee an opportunity to establish the transferee deposit sub-account; and

means for the depository administrator to process the funds between the transferor deposit sub-account and the transferee deposit sub-account, wherein each of the sub-accounts forms part of the master account such that a transfer of funds between sub-accounts does not affect a balance in the master account.

(IX) EVIDENCE APPENDIX

(NOT APPLICABLE)

UNDERSTEIN
Serial No. 10/510,123

(X) RELATED PROCEEDINGS APPENDIX

(NOT APPLICABLE)